

REMARKS

Claims 1-7 and 28-34 are pending in the application.

Claims 1-7 and 28-34 have been rejected.

Claims 1, 2, 6 and 28 have been amended, as set forth herein.

Claim 3 has been canceled, without prejudice.

I. **REJECTION UNDER 35 U.S.C. § 102**

Claim 28 was rejected under 35 U.S.C. § 102(b) as being anticipated by Rainey (US 6,168,351). The rejection is respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

In the last response, Applicant amended independent Claim 28 to recite that the wale “is of a unitary construction.” Rainey does not disclose this element/feature. As shown in Figure 4 of

Rainey, the back wall 48, front wall 50 and plurality of connecting walls 44, 46, as identified by the Office Action, are not constructed together such that the wale “is of a unitary construction.”¹

Accordingly, the Applicant respectfully requests the Examiner withdraw the § 102(b) rejection of Claim 28.

II. REJECTIONS UNDER 35 U.S.C. § 103

Claims 1, 2, 6, 28, 33 and 34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Weber (US 5,435,669). Claims 3, 7 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Weber (US 5,435,669) in view of Fox (US 5,765,970). Claims 4, 5, 31 and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rainey (US 6,168,351) in view of Enduro Systems DuroThread Fastener & Hanging System (“Enduro”). Claim 29 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Rainey (US 6,168,351). The rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d

¹ Applicant further respectfully submits that the identified elements of Rainey do not constitute a “wale”, as the elements 48, 50 are “flanged washers.” Col. 3, line 61.

1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

a. Rejection of independent Claims 1, 6 and 28 (and dependent Claims 2, 33 and 34)

As noted in Applicant's last response, though the panel members (87, 74) of Weber are horizontal construction members, these members are not used for bracing the vertical members. In fact, the panel members (87, 74) are designed and used to form the retaining wall panels themselves (extending horizontally lengthwise), which are inserted into the vertical pilings. See, Abstract; Figure 1. Weber's vertical pilings 12 brace the panel members (87,74), which panel members the Office Action is identifying as the wale. In contrast, Applicant's wale is used for bracing the members that form the retaining wall (i.e., the panels). Therefore, Weber's device (the panel members as identified by the Examiner to be a "wale") do not appear to meet this definition. Moreover, Weber provides small weepage holes in the horizontal wall member because it is desirable for a uniformly constructed wall, such as a wall constructed from the wall members (87, 74), to address water weepage. Thus, it is clear that the wall members (87,74) of Weber are used to construct the wall itself, and do not and are not intended to function in Weber as a conventional "wale" member.²

However, Applicant has amended independent Claims 1 and 6 to recite several walls/members that form a plurality of chambers within the wale. See, Claims 1 and 6, as amended. Applicant has also amended independent Claims 1, 6 and 28 to recite that the channel extends from

² Weber does describe using tie-back cables in conjunction with tie-back lagging members 184 but these tie-back lagging members still form part of the main wall portion and do not include either (1) a channel extending from a first end to a second end of the member, or (2) that this recited channel has the channel depth, as recited in Applicant's claims (as amended). Weber, Figures 17, 18, Col. 12, line 27 through Col. 13, line 39.

a first end to a second end of the wale. Weber does not disclose, teach or suggest these recited features/elements.

For these reasons, Weber fails to sufficiently provide the necessary elements and teachings to establish a prima facie 103 rejection of independent Claims 1, 6 and 28 (and dependent claims), as amended.

Based upon the foregoing, there is no disclosure, teaching, suggestion or motivation to modify Weber as claimed by the Applicant in independent Claims 1, 6 and 28 (and their dependent Claims), therefore, Applicant's claimed invention is not obvious in view of Weber.

b. Rejection of Claims 3, 7 and 30

With respect to the rejection of dependent Claims 3 (now canceled), 7 (as amended) and 30, Applicant reiterates from above the noted deficiencies of Weber. The wall member portions 12 of Fox constitute the wall portions. It is apparent that Fox's vertical whaler posts 44 stabilize and brace the retaining wall 10. Similar to Weber, Fox' design and method of connection of the retaining wall is substantially different from Applicant's description - as Fox's panel members 12 form the wall, and the vertical whaler posts 44 that brace and connect to the retaining wall 10. Importantly, Fox's panel member does not include (1) a channel (with sufficient depth) or (2) the recited channel extending from a first end to a second end of the wale.

Therefore, Fox fails to disclose, teach or suggest (1) a wale having a channel formed therein and extending from a first end to a second end of the wale, and (2) wherein the channel has a

sufficient depth such that when the wale is secured to the retaining wall by a tieback rod passing through the wale and a fastener, the tieback rod and the fastener do not protrude from the channel.

Based upon the foregoing, there is no disclosure, teaching, suggestion or motivation to modify or combine Weber with Fox, and even if combinable, the proposed combination fails to disclose, teach or suggest each and every element/feature of Applicant's claims arranged as they are in the claims (as amended).

c. Rejection of Claims 4, 5, 31 and 32

The Office Action states that Rainey discloses all of the features of independent Claims 1 and 28.

With respect to independent Claim 1, the Office Action fails to identify the elements of Rainey that are equivalent to Applicant's claimed invention. Notwithstanding, there is no disclosure in Rainey of a channel with the recited depth.

With respect to independent Claim 28, Applicant refers to its remarks above illustrating that Rainey fails to disclose "wherein said wale is of a unitary construction."

The Enduro Systems reference fails to disclose, teach or suggest those elements missing from Rainey. With respect to the rejection of Claims 4, 5, 31 and 32, the Enduro reference is simply not relevant. This reference fails to disclose, teach or suggest any application to retaining walls and wales. At most, the reference discloses threaded bolts, nuts and washers made of non-metallic material, and fails to relate to a wale comprising composite material, as claimed in Applicant's

claims. Therefore, the Office Action has failed to establish a prima facie case of obviousness of Claims 4, 5, 31, and 32.

As such, the proposed combination fails to disclose, teach or suggest Applicant's claimed invention.

d. Rejection of Claim 29

As noted above with respect to independent Claim 28 (from which Claim 29 depends) Rainey fails to disclose "wherein said wale is of a unitary construction." As a result, the Office Action has failed to establish a prima facie case of obviousness for dependent Claim 29 (or independent Claim 28)

Accordingly, the Applicant respectfully requests withdrawal of all the § 103(a) rejections of Claims 1, 2, 4-7 and 28-34.

III. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

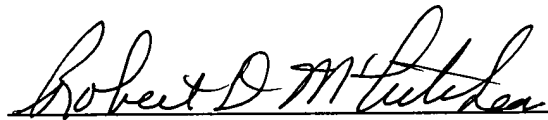
If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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